

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BARRY H. SCHWAB

Appeal No. 1998-1677
Application No. 08/273,251

HEARD: November 14, 2000

Before BARRETT, FLEMING, and BARRY, Administrative Patent Judges.

FLEMING, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 17 and 19.

Claims 1 through 16 and 21 have been allowed.

Claim 18 has been canceled.

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Claim 20 has been withdrawn from consideration.

The invention relates to magnetic tape duplication. In particular, the invention relates to a machine capable of simultaneous high-speed duplication and cassette loading.

Independent claim 17 is reproduced as follows;

17. In a combined magnetic tape duplicator and cassette loader the method of producing copy-tape cassettes from a master tape, comprising the steps of:

- a) providing master tape in the form of a mirror master;
- b) providing copy tape on at least one pancake-type supply reel;
- c) threading said master and said copy tape through contact duplication means;
- d) cueing said master tape for a transfer operation;
- e) transferring a magnetically encoded pattern on said master to said copy tape using said contact duplication means; and
- f) loading copy tape having said magnetically encoded pattern transferred thereupon into a cassette, the path followed by said copy tape from said contact duplication means to said cassette forming a continuous, unbroken tape path.

The Examiner relies on the following references:

Grindley et al. (Grindley)	3,864,732	Feb. 4,
1975		
Kanematsu	JP 4-61027	Feb. 27,
1992		

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(Japanese)

The previous grounds of rejection have been withdrawn in view of the Applicant's comments. See page 4 of the Examiner's Answer. A new ground of rejection has been set forth by the Examiner. As per this new ground of rejection, claims 17 and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Grindley in view of Kanematsu.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the briefs¹ and answer for the respective details thereof.

OPINION

We will not sustain the rejection of claims 17 and 19 under 35 U.S.C. § 103.

The Examiner has failed to set forth a ***prima facie*** case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the

¹Appellant filed an appeal brief on October 6, 1997. Appellant filed a reply brief December 10, 1997. The examiner mailed an office communication on January 9, 1998, stating that the reply brief has been entered. The Examiner stated that no further response is deemed necessary by the Examiner.

prior art, or by implications contained in such teachings or suggestions. ***In re Sernaker***, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." ***Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.***, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), ***cert. denied***, 519 U.S. 822 (1996) (***citing W. L. Gore & Assoc., Inc. v. Garlock, Inc.***, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), ***cert. denied***, 469 U.S. 851 (1984)).

On pages 3 through 6 of the reply brief, Appellant argues that it would not have been obvious to one of ordinary skill in the art at the time of the invention to replace the electronic copying arrangement as disclosed by Grindley with a contact type copying arrangement as taught by Kanematsu, since each performs entirely different functions to acquire substantially different results. Appellant points out that Grindley uses a common capstan to synchronize the movement of a master and a plurality of copy tapes to effectuate an analog re-recording. Appellant also points out that Kanematsu uses

some form of direct transfer process. Appellant argues that there is no hint or suggestion in Grindley that it would be compatible with, or benefit by, contact duplication.

Appellant further argues that the Examiner is suggesting that if the teachings of Kanematsu be applied to those of Grindley, it would result in wholesale replacement of Grindley's playback and recording heads, and associated electronics, with Kanematsu's contact recording apparatus. Appellant argues that this would undermine one of Grindley's stated and claimed points of novelty in that it would preclude Grindley's use of a common capstan.

The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." ***In re Fritch***, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992) (***citing In re Gordon***, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). It is further established that "[s]uch a suggestion may come from the nature of the problem to be solved, leading inventors to look to

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references relating to possible solutions to that problem."

Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), (**citing In re Rinehart**, 531 F.2d 1048, 1054, 189 USPQ 143, 149 (CCPA 1976) (considering the problem to be solved in a determination of obviousness)). The Federal Circuit reasons in **Para-Ordnance Mfg. Inc. v. SGS Importers Int'l Inc.**, 73 F.3d 1085, 1088-89, 37 USPQ2d 1237, 1239-40 (Fed. Cir. 1995), **cert. denied**, 519 U.S. 822 (1996), that for the determination of obviousness, the court must answer whether one of ordinary skill in the art who sets out to solve the problem and who had before him in his workshop the prior art, would have been reasonably expected to use the solution that is claimed by the Appellants. However, "[o]bviousness may not be established using hindsight or in view of the teachings or suggestions of the invention." **Para-Ordnance Mfg. v. SGS Importers Int'l**, 73 F.3d at 1087, 37 USPQ2d at 1239 (**citing W. L. Gore & Assoc., Inc. v. Garlock Inc.**, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13). In addition, our reviewing court requires the PTO to make

specific findings on a suggestion to combine prior art references. *In re Dembiczak*, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

In column 1, lines 35 through 37, we find that Grindley teaches that their invention provides for a complete control of the receiving tapes on each panel through a single capstan. In column 1, lines 37 through 40, Grindley teaches that this capstan drives each of the receiving magnetic tapes across their respective magnetic recording heads and also drives the take-up reel located within each cartridge. In column 1, lines 40 through 45, Grindley states that the common capstan drive provides the required resistance to prevent backlash on the supply reel, brake shoes are automatically operated by floating arm tension mechanisms through eccentric mounts. In columns 2 and 3, Grindley discloses an apparatus in which a single capstan **36** is used to drive all of the magnetic tapes **46** past the magnetic tape **30** as well as the cartridge take-up reel **70**. In the abstract, Grindley states that each receiving tape is mounted on a separate panel and is driven by a capstan common to the master and all receiving tapes.

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Upon our review of Grindley and Kanematsu, we fail to find any suggestion as to why one of ordinary skill in the art would choose to destroy a principal operation of Grindley, the common capstan, in favor of using the Kanematsu mechanism. We note that the Examiner's specific finding as to the suggestion is simply a statement that Grindley and Kanematsu are used in similar environments performing similar functions to acquire similar results. Upon our review of Grindley and Kanematsu, we do not find this to be true as pointed out above. Therefore, we will not sustain the Examiner's rejection of claims 17 and 19 under 35 U.S.C. § 103.

In view of the foregoing, the Examiner's decision is reversed.

REVERSED

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